

## **REMARKS**

Claims 34 through 42 are pending in the application, and were finally rejected. Claims 34 through 42 were rejected. Applicants respectfully request consideration of the amendments below, and the withdraw of the rejection in view of the remarks in the appeal brief.

## **REJECTION UNDER 35 U.S.C. § 103**

Claims 34 - 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ponzi (U.S. Pat. No. 5,964,757). This rejection is respectfully traversed.

With respect to claims 34, 35 and 39, these claims have been amended to clarify that the one or more magnetic members disposed in the distal end of the catheter are *oriented by an externally applied magnetic field*. This amendment does not introduce new structure or alter the structure of the claimed invention, and does not introduce subject matter outside of the scope of the Examiner's search. Applicants further believe that the amendment places the claims in a condition for allowance.

The Final Office Action states on page 4 that Ponzi discloses one or more magnet members (such as 72, etc.), as recited in columns 9 and 10 in Ponzi. However, the electromagnetic sensor 72 disclosed in Ponzi is used for sensing location, and is not intended to be oriented by an externally applied magnetic field. The whole point of the electromagnetic sensor 72 was to **sense** the location of the distal tip rather than to **move** the sensor. If the electromagnetic sensor 72 moved during an attempt to sense location using an externally applied magnetic field, any attempt to sense location of the electromagnetic sensor via an external magnetic field would be counter-productive.

While the electromagnetic sensor 72 disclosed in Ponzi could possibly be inherently responsive to magnetic fields, it is well know by one of ordinary skill that

magnet attraction force falls off with the fourth power of distance and would not cause any appreciable response. Furthermore, there is no indication in Ponzi that the electromagnetic sensor 72 could inherently be oriented, or moved at all, by an externally applied magnetic field. This is inconsistent with the factual inquiries for determining obviousness set forth in *Graham v. John Deer Co.*, 383 U.S. 1, 148 USPQ 459 (1966).

There must be evidence to reasonably support the determination that an electromagnetic sensor in the distal end of a catheter inherently would be oriented by an externally applied magnetic field. The mere fact that a certain thing could result from a given set of circumstances is not sufficient to support the determination that orientation is possible. A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to employ the relevant teachings of the references to arrive at the claimed invention. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1998). Movement of the Ponzi electromagnetic sensor, if at all possible, is not the same as orienting the distal tip, which the magnets (24, 432, 526, 618) in the present invention provide for. Thus, the examiner has not met the burden of presenting a prima facie case of obviousness. As such, Applicants believe that claims 34, 35 and 39 as currently amended are not obvious in view of Ponzi, and are patentable.

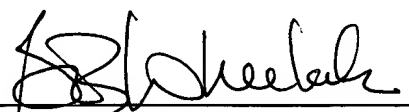
With respect to claims 36 through 38, these claims depend from claim 35, which applicants believe to be allowable as currently amended. Thus, for at least these reasons, Applicants submit that claims 36 through 38 are also in a condition for allowance.

With respect to claims 40 through 42, these claims depend from claim 39, which applicants believe to be allowable as currently amended. Thus, for at least these reasons, Applicants submit that claims 40 through 42 are also in a condition for allowance.

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (314) 726-7500.

Respectfully submitted,

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